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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,249	02/27/2006	Goulven Jean Vernois		5022

7590 05/24/2010
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EXAMINER

KIM, STEVEN S

ART UNIT	PAPER NUMBER
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3685

MAIL DATE	DELIVERY MODE
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05/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,249	Applicant(s) VERNOIS, GOULVEN JEAN	
	Examiner STEVEN KIM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the Applicant's communication dated May 10, 2010.
2. In regards to the Applicant's request for divisional application for non-elected claims 15-18, Examiner points Applicant to MPEP 201.07 that relates to Continuation Application.

Status of Claims

3. Claims 1-8, 19, and 20 have been canceled.
4. Claims 9-14 have been examined.
5. Claims 15-18 have been withdrawn.

Acknowledgement(s)

6. The Applicant's election on claims 9-14 *without traverse* in the reply on May 10, 2010 is acknowledged. Claims 15-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group(s).
7. The Applicant's request for change of title of the instant application to "Data machine with creation and comparison of fingerprints" has been acknowledged. The change to the title will be held in abeyance until the current application is ready for allowance.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “numerical fingerprint” in claims 9-12.

9. It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT/FR04/01454, filed June 10, 2004, which claims priority of France Application 03/07104 filed on June 12, 2003. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111 (a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) or sixteen months

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from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

10. If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

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in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Objections

11. Claims 9-14 objected to because of the following informalities:

- “*independant* data” in claim 9 appears to be typo;
- “*analysys*” in claims 12 and 13 appear to be typo;
- “characterized” in claims 13 and 14 appear to be typo.

12. Appropriate correction is required.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claims 9-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

15. Per claims 9-14, the recited “means of analysis” is directed to living subject matter, e.g. human (see ¶0015 of the instant application US Patent Application No. 2006/0236058). See MPEP 2105.

Claim Rejections - 35 USC § 112, 1st paragraph

16. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

18. Per Claims 9-14, the claims are directed to creation of numerical fingerprints of data works and/or comparing of numerical fingerprints. The original written disclosure does not disclose the claimed element(s). Claims 11-14 are rejected similarly as each depends on claim 9.

19. Additional elements not disclosed in the original written disclosure are:

- "creates a numerical fingerprint of each data works brought by the creator" claim 10;
- "to each data work contained in the mass memory is added its numerical fingerprint" claim 11;
- "compare the numerical fingerprints of the data works brought by the creator with the numerical fingerprints contained in the mass memory" claim 12;

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- “accepts or refuses the loading on the mass memory of the data works brought by the creator and in standby in the intermediate memory” claim 13; and
- “in case of indecision of the means of analysis, this means calls distant means, computer means or human means” claim 14.

Claim Rejections - 35 USC § 112, 2nd Paragraph

20. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

22. Claims 9-14 rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

23. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

24. Per claim 9-14, the claim recites “a means of selection”, “a means of loading”, “a means of setting”, “a means of payment”, “a means of availability”, “a means of

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reading”, “a means of intermediate memory”, “a means of writing”, and “means of analysis”. Claims 10, 12, 13, and 14 also recite “means of”. Per MPEP 2181, a claim limitation will be presumed to invoke 35 USC 112, 6th paragraph, if it meets the following 3-prong analysis: (A) the claim limitations must use the phrase “means for” or “step for;” (B) the “means for” or “step for” must be modified by functional language; and (C) the phrase “means for” or “step for” must not be modified by sufficient structure, material, or acts for achieving the specified function. It is unclear whether the Applicant intended “means of” to invoke 35 USC 112, 6th paragraph. For the purpose of prosecution, the “means of” will be interpreted as “means for”. If it is the Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant(s) to amend the claim language to “means for”.

25. Moreover, claims 9-14 element “means for” is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. While the written description contain “mean for” language, the written descriptions fails to clearly link the disclosed structure, material, or acts to the claimed function. For example, the specification refers to “means of analysis” as automatic or human (see ¶0015; ¶0032; ¶0048 of the instant application US Patent Application No. 2006/0236058). The specification references the “means of analysis” as local 12 or distant 12a in the singular drawing of the instant application. In the case where the “means of analysis” is automatic, what is the

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corresponding structure, material, or acts perform the claimed function? The specification merely describes the functionality of “means of analysis” while 12 and 12a of the drawing represent blocks representing the placeholders of the functionality. Similar analysis is applicable to other recited “means of” which is interpreted as “means for”.

26. The Applicant is required to:

- amend the claims so that the claim limitations will no longer be a means plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or
- state on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

27. The recited “means for *selection of the data contained in the mass memory*” is unclear. For example, the claim is directed to an autonomous data distributing machine. What is the intended function of “selection of the data contained in the mass memory” given the scope of the machine. Examiner will interpret as “means for selecting a data contained in the mass memory”.

28. The recited “means for *payment of the said price*” is unclear. Examiner will interpret as “means for receiving payment of the said price”.

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29. The recited “a means for *availability* of these independent data supports to customers” is unclear. First, it is unclear what *these* independent data supports represent. Secondly, it is unclear what the intended function “availability of these independent data supports to customers”. Examiner will interpret as “a means for providing the independent supports to customers”.

30. The recited “a means for intermediate memory to put in standby the data brought by a creator” fails the third prong test for 112, 6th paragraph, since the means for is modified by a structure, e.g. intermediate memory. Similarly, the recited “a means of writing on the mass memory the data brought by a creator” fails the third prong test.

31. The recited “means of analysis allowing the creation of numerical fingerprints” is unclear. Examiner will interpret as “means for allowing the creation of numerical fingerprints”.

32. The recited “characterized in that it has means” is unclear since it can refer to many components.

33. As per claim 10, the recited “characterized in that the means of analysis creates a numerical fingerprint of each data works brought by the creator” is unclear. For example, what is the intended functionality and/or the component performing the functionality?

34. Similarly, the recited “characterized in that the means of analysis compare the numerical fingerprints of the data works brought by the creator with the numerical fingerprints contained in the mass memory” in claim 12 and the recited “characterized in

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that the means of analysis accepts or refuses the loading on the mass memory of the data works brought by the creator and in standby in the intermediate memory” in claim 13 are unclear.

35. As per claim 14, the recited “characterized in that in case of indecision of the means of analysis, this means calls distant means, computer means or human means” is unclear. First it is unclear what “means of analysis” is. Secondly, the claim suggests some action as a result of some analysis. The claim, however, does not suggest action. Furthermore, it is unclear what “this means calls distant means, computer means or human means” is intended.

36. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. See *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

37. The Examiner finds that because the claims are indefinite under 35 U.S.C. § 112, 2nd paragraph, and in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

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Claim Rejections - 35 USC § 103

38. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

39. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,633,839 ("Alexander") in view of US Patent No. 5,892,900 ("Ginter").

40. Per claim 9, Alexander discloses autonomous data distributing machine (see Fig. 1; col. 1, lines 5-10) having at least :

- a mass memory containing the data intended to be sold by the distributing machine (see Fig. 1; Fig. 3, disk drive 30; col. 2, lines 63-65);
- a means of selection of the data contained in the mass memory (see Fig. 2; Fig. 3, keyboard; col. 2, lines 48-53; col. 2, line 66 – col. 3, line 5; col. 3, lines 6-37);
- a means of loading the data selected on independent data supports (see Fig. 3; col. 2, line 66 – col. 4, line 5);
- a means of setting the price to pay by customer to obtain the independent data support loaded with selected data (see Fig. 2, payment instructions 14; col. 2, line 66 – col. 4, line 5);
- a means of payment of the said price (see Fig. 2, payment section 16, col. 2, lines 46-47); and

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- a means of availability of these independent data supports to customers (see Fig. 3, CD storage 40 and CD writer and dispenser 34);
- a means of intermediate memory to put in standby the data brought by a creator (see Fig. 3, Random Access Memory 32);
- a means of writing on the mass memory the data brought by a creator (see Fig. 3, disk drive 30).

41. Alexander does not disclose a machine characterized in that it has means of analysis allowing the creation of numerical fingerprints of musical and audio-video data works and allowing the comparison of such numerical fingerprints. Ginter, however, discloses a fingerprinting or watermarking electronic assets, e.g. audio/video contents (see Fig. 70B; col. 1, lines 6-35; col. 141, lines 5-35; col. 37, line 15 – col. 38, line 35; col. 202, line 40 – col. 205, line 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the watermarking or fingerprinting technique as disclosed in Ginter to Alexander, as both are related to distribution of electronic content, to improve security and authenticity.

42. Ginter discloses a means of reading independent data supports brought by a creator (see Fig. 7; col. 63, lines 13-15; col. 82, lines 19-23; col. 83, line 66 – col. 54, line 3).

43. In regards to claims 10-14, the claims are directed to obvious fingerprint features, e.g. creating/adding fingerprint to data work, comparing fingerprints, accepting/refusing data work based on fingerprint authentication. Ginter discloses fingerprinting and

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watermarking techniques (see Fig. 70B; col. 1, lines 6-35; col. 141, lines 5-35; col. 37, line 15 – col. 38, line 35; col. 202, line 40 – col. 205, line 20). Furthermore, accepting/refusing data work based on authentication of fingerprint is obvious feature of authentication.

Conclusion

44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./

Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685